

1 Staci Jennifer Riordan, SBN 232659  
Jessica N. Walker, SBN 275398  
2 **NIXON PEABODY LLP**  
One California Plaza  
3 300 S. Grand Avenue, Suite 4100  
Los Angeles, CA 90071  
4 Telephone: 213.629.6000  
Facsimile: 213.629.6001  
5 sriordan@nixonpeabody.com  
jwalker@nixonpeabody.com

6 Attorneys for Defendant  
7 H & M HENNES & MAURITZ LP

8  
9  
10 UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

11  
12 UNICOLORS, INC., a California  
13 Corporation,

14 Plaintiff,

15 vs.

16 H & M HENNES & MAURITZ LP, a  
New York Limited Partnership, and  
17 DOES 1-20, inclusive,

18 Defendants.

Case No.: 2:16-cv-02322

Hon. André Birotte, Jr.

**DEFENDANT H & M HENNES &  
MAURITZ LP'S OPPOSITION TO  
PLAINTIFF'S NOTICE OF MOTION  
AND MOTION FOR SUMMARY  
JUDGMENT AND/OR  
ADJUDICATION; DEFENDANT'S  
MOTION FOR SUMMARY  
JUDGMENT OR IN THE  
ALTERNATIVE SUMMARY  
ADJUDICATION; MEMORANDUM  
OF POINTS AND AUTHORITIES IN  
SUPPORT THEREOF**

[Filed Concurrently with Declaration of  
Staci Jennifer Riordan; Declaration of  
Chelsea Wharton; Declaration of  
Xiaomin Qian; Statement of Genuine  
Disputes of Material Fact; Objections to  
Evidence; [Proposed] Order]

Date: May 22, 2017  
Time: 10:00 a.m.  
Ctm.: 7B

Pretrial Conf.: August 7, 2017  
Trial Date: August 29, 2017

## Table of Contents

	Page
I. INTRODUCTION .....	1
II. STATEMENT OF FACTS .....	1
A. H&M Operates Retail Stores in the United States.....	1
B. Unicolors is a Domestic Textile Converter.....	1
C. H&M’s Garments Bear a Design that was Independently Created .....	2
D. H&M Did Not Design or Manufacture the Accused Garments.....	3
E. H&M Lost Money on Sales of the Accused Garments .....	3
III. STANDARD FOR MOTION FOR SUMMARY JUDGMENT .....	3
IV. THE FABRIC DESIGN WAS INDEPENDENTLY CREATED AND IS COVERED BY A VALID COPYRIGHT REGISTRATION .....	4
A. Xue Xu was Independently Created and Protected by Copyright .....	4
B. The Accused Garments Contain the Design Xue Xu.....	5
V. H&M IS NOT LIABLE FOR COPYRIGHT INFRINGEMENT.....	6
VI. UNICOLORS CANNOT PROVE THAT H&M ACCESSED EH101 .....	6
A. Plaintiff Has Not Established Facts Demonstrating Direct Access .....	7
B. Plaintiff Has Not Established Access By A “Chain of Events” .....	7
C. Plaintiff Has Not Shown Access By Widespread Dissemination.....	7
D. Unicolors Cannot Meet Its Access Burden via Striking Similarity ....	11
VII. EH101 AND XUE XU ARE NOT SUBSTANTIALLY SIMILAR.....	12
A. The Unprotected Elements Of The Shape Pattern Must Be Filtered Out Before It Is Compared With The Garments .....	13
B. EH101’s Standard And Stock Elements Are Not Protectable .....	15
C. Unicolors Relied Upon And Borrowed From Ancient And Public Domain Patterns In Creating The Shape Pattern .....	15
D. The Use Of Triangles, Diamonds, “X” Symbols, Pyramids, and Circles Are Scènes à Faire and Unprotectable In Fabric Patterns .....	17
VIII. EH101 IS NOT PROTECTABLE AS A COMBINATION OF OTHERWISE UNPROTECTABLE ELEMENTS .....	18

1 IX. MANUFACTURING HAS NO BEARING ON THE SUBSTANTIAL  
2 SIMILARITY ANALYSIS ..... 19  
3 X. COMPARISON REVEALS EH101 AND XUE XU ARE NOT  
4 SUBSTANTIALLY SIMILAR ..... 20  
5 XI. THE WORKS ARE NOT VIRTUALLY IDENTICAL ..... 23  
6 XII. H&M CANNOT BE SECONDARILY LIABLE FOR  
7 EXTRATERRITORIAL INFRINGEMENT ..... 23  
8 XIII. UNICOLORS’ ALLEGED DAMAGES ..... 24  
9 XIV. H&M’S FEES ..... 25  
10 XV. CONCLUSION..... 25  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

## TABLE OF AUTHORITIES

Page(s)

### FEDERAL CASES

<i>Aliotti v. R. Dakin &amp; Co.</i> , 831 F.2d 898 (9th Cir. 1987) .....	15
<i>Apple Computer Inc. v. Microsoft Corp.</i> , 35 F.3d 1435 (9th Cir. 1994) .....	14
<i>Art Attacks Ink, LLC v. MGA Entertainment Inc.</i> ("Art Attacks"), 581 F.3d 1138 (9th Cir. 2009) .....	7, 8, 9, 10
<i>Bernal v. Paradigm Talent &amp; Literary Agency</i> , 788 F. Supp. 2d 1043 (C.D. Cal. 2010) .....	6, 11, 23
<i>Bethea v. Burnett</i> , 2005 WL 1720631 (C.D. Cal. June 28, 2005) .....	12
<i>Bill Diodato Photography, LLC v. Kate Spade, LLC</i> , 388 F. Supp. 2d 382 (S.D.N.Y. 2005) .....	17
<i>Brown Bag Software v. Symantec Corp.</i> , 960 F.2d 1465 (9th Cir. 1992) .....	14
<i>Cavalier v. Random House</i> , 297 F.3d 815 (9th Cir. 2002) .....	13
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986) .....	4
<i>Columbia Pictures Indus., Inc. v. Fung</i> , 2009 WL 6355911 (C.D. Cal. Dec. 21, 2009), <i>aff'd in part as modified</i> , 710 F.3d 1020 (9th Cir. 2013) .....	24
<i>Creative Tech., Ltd. v. Aztech Sys. Pte., Ltd.</i> , 61 F.3d 696 (9th Cir. 1995) .....	5
<i>Data Eas USA v. Epyx, Inc.</i> , 862 F.2d 204 (9th Cir. 1988) .....	14
<i>Ent'mt Research Grp. V. Genesis Creative Grp.</i> , 122 F.3d 1211 (9th Cir. 1997) .....	13

1	<i>Erickson v. Blake,</i>	
2	839 F. Supp. 2d 1132 (D. Or. 2012).....	14
3	<i>Feist Publications, Inc. v. Rural Tel. Serv. Co.,</i>	
4	499 U.S. 340 (1991).....	18
5	<i>Hamil America, Inc. v. GFI,</i>	
6	193 F.3d 92 (2d Cir. 1999) .....	5
7	<i>Kamar International v. Russ Berrie &amp; Co.,</i>	
8	657 F.2d 1059 (9th Cir. 1981) .....	7
9	<i>L.A. News Serv. v. Reuters Television Int’l, Ltd.,</i>	
10	149 F.3d 987 (9th Cir. 1998) .....	24
11	<i>L.A. Printex Indust. Inc. v. Aeropostale, Inc.,</i>	
12	676 F.3d 841 (9th Cir. 2012) .....	passim
13	<i>Lambert Corp. v LBJC Inc.,</i>	
14	2014 WL 2737913 (C.D Cal. June 16, 2014).....	12
15	<i>Lamps Plus, Inc. v. Seattle Lighting Fixture Co.,</i>	
16	345 F.3d 1140 (9th Cir. 2003) .....	5, 19
17	<i>Landsberg v. Scrabble Crossword Game Players, Inc.,</i>	
18	736 F.2d 485 (9th Cir. 1984) .....	17
19	<i>Lilith Games (Shanghai) Co. v. uCool, Inc.,</i>	
20	2015 WL 4149066 (N.D. Cal. July 9, 2015) .....	3, 5
21	<i>Meta–Film Assoc. v. MCA, Inc.,</i>	
22	586 F. Supp. 1346 (C.D. Cal. 1984).....	7
23	<i>Norse v. City of Santa Cruz,</i>	
24	629 F.3d 966 (9th Cir. 2010) .....	4
25	<i>Perfect 10, Inc. v. Yandex N.V.,</i>	
26	2013 WL 4777189 (N.D. Cal. Sept. 6, 2013).....	24
27	<i>Peter Starr Prod. Co. v. Twin Continental Films, Inc.,</i>	
28	783 F.2d 1440 (9th Cir. 1986) .....	24
	<i>Polar Bear Prods., Inc. v. Timex Corp.,</i>	
	384 F.3d 700 (9th Cir. 2004) .....	25

1	<i>Roth Greeting Cards v. United Card Co.</i> ,	
2	429 F.2d 1106 (9th Cir. 1970) .....	5
3	<i>Satava v. Lowry</i> ,	
4	323 F. 3d 805 (9th Cir. 2003) .....	14, 18, 19
5	<i>Star Fabrics, Inc. v. The Wet Seal, Inc., et. al.</i> ,	
6	Dkt. No. 23, p. 3 (C.D. Cal. Mar. 27, 2015).....	12
7	<i>Stratchborneo v. Arc Music Corp.</i>	
8	357 F. Supp. 1393 (S.D.N.Y 1973) .....	11
9	<i>Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.</i> ,	
10	24 F.3d 1088 (9th Cir. 1994) .....	24
11	<i>Testa v. Janssen</i> ,	
12	492 F. Supp. 198 (W.D. Pa. 1980) .....	11
13	<i>Three Boys Music Corp. v. Bolton</i> ,	
14	212 F.3d 477 (9th Cir. 2000) .....	6, 7
15	<i>Twentieth Century-Fox Film Corp. v. MCA, Inc.</i> ,	
16	715 F.2d 1327 (9th Cir. 1986) .....	13
17	<i>Walker v. Viacom Int'l, Inc.</i> ,	
18	2008 WL 2050964 (N.D. Cal. May 13, 2008), <i>aff'd</i> , 362 F. App'x 858 (9th	
19	Cir. 2010) .....	6
20	<b>FEDERAL STATUTES</b>	
21	17 U.S.C. § 505.....	25
22	<b>RULES</b>	
23	Fed. R. Civ. P. 56(f).....	4
24	Fed. R. Civ. P. 902.....	4
25	<b>REGULATIONS</b>	
26	37 C.F.R. § 202.1 .....	15

1 **OTHER AUTHORITIES**

2 4-13 M. Nimmer & D. Nimmer, *Nimmer on Copyright*  
3 (“Nimmer”) (2015) .....4, 24  
4 Mary Campbell Wojcik, *The Antithesis of Originality: Bridgeman, Image*  
5 *Licensors, and the Public Domain*, 30 Hastings Comm. & Ent. L.J. 257, 267  
6 (2008).....15, 16  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**TO PLAINTIFF AND TO ITS ATTORNEYS OF RECORD:**

PLEASE TAKE NOTICE that on May 22, 2017, at 10:00 a.m., or as soon thereafter as the matter may be heard in the above-entitled court, located at 350 W. 1st St., Los Angeles, California, 90012, Defendant H & M Hennes & Mauritz LP (“H&M” or “Defendant”) will and does hereby move the Court to deny Plaintiff’s motion for summary judgment and, on the ground that there is no genuine issue as to any material fact, instead find that H&M is entitled to summary judgment, or alternatively, summary adjudication as to one or more of Plaintiff’s claims, as a matter of law.

Plaintiff’s first claim for relief for direct copyright infringement fails for the following reasons:

- Defendant has undisputed evidence that the accused design was the result of independent creation.
- Plaintiff cannot establish that: (1) the accused design is strikingly similar to the copyrighted material; or (2) the accused design the substantially similar to the copyrighted material and that Defendant had access to the copyrighted material.

Plaintiff’s second claim for relief for contributory copyright infringement fails for the following reason:

- The predicate sales took place outside the United States and, as a matter of law, cannot support a claim for contributory infringement.

Plaintiff’s third claim for relief for vicarious copyright infringement fails for the following reason:

- The predicate sales took place outside the United States and, as a matter of law, cannot support a claim for vicarious infringement.

///

///

///



1                   **CERTIFICATE OF COMPLIANCE WITH LOCAL RULE 7-3**

2           Pursuant to Local Rule 7-3, the parties met and conferred on April 17, 2017 to  
3 discuss the basis of their anticipated motions. Pursuant to this Court's standing order,  
4 and prohibition against cross-motions, the parties agreed that Plaintiff would be the  
5 moving party, and Defendant would assert its motion for summary judgment by way  
6 of its opposition.

7                   **OPPOSITION AND MOTION**

8           This opposition and motion is based upon this Notice; the attached  
9 Memorandum of Points and Authorities; the accompanying Declaration of Staci  
10 Jennifer Riordan; [Proposed] Order; all of the pleadings and papers filed herein; and  
11 any argument or evidence that may be presented to or considered by the Court prior to  
12 its ruling.

13  
14 Dated: May 1, 2017

NIXON PEABODY LLP

15  
16 By /s/ Staci Jennifer Riordan  
17 Staci Jennifer Riordan  
18 Jessica N. Walker  
19 Attorneys for Defendant  
20 H & M HENNES & MAURITZ, LP  
21  
22  
23  
24  
25  
26  
27  
28

## **MEMORANDUM OF POINTS AND AUTHORITIES**

### **I. INTRODUCTION**

This case is very simple. H&M did not copy Unicolors' design, EH101. The design on the fabric used for H&M's garments, called "Xue Xu," was copyrighted by the supplier who created it. Moreover, H&M does not design or manufacturer any of the products in its stores, so not only did it not access EH101, it would have no reason to access it.

And it may surprise the Court to learn that the foregoing is undisputed by Unicolors. Nonetheless, seeing H&M as a deep pocket, Unicolors speciously persists with its claim. And as serial copyright trolls tend to do, when Unicolors realized it has no evidence to support any of its claims, it started (falsely) accusing H&M of wrongdoing, perhaps hoping that sideshow will distract the Court. Don't reward Unicolors' improper conduct or be fooled by smoke and mirrors.

The undisputed facts before the Court establish, as a matter of law, that all three of Plaintiff's claims fail and that summary judgment should be entered in Defendant's favor, *in toto*.

### **II. STATEMENT OF FACTS**

#### **A. H&M Operates Retail Stores in the United States**

H & M Hennes & Mauritz LP ("H&M"), based in New York, owns and operates numerous retail stores across the United States that sell fashion-forward clothing for men, women and children. Statement of Genuine Disputes of Material Facts ("SGDMF") 28. H&M does not design any of the products in its stores. SGDMF 29. H&M does not manufacture any of the products in its stores. SGDMF 30. H&M's primary function is to operate its stores in a way to support its sales associates to maximize sales, both in volume and units. SGDMF 31.

#### **B. Unicolors is a Domestic Textile Converter**

Unicolors, Inc. ("Unicolors"), based on Los Angeles, creates designs for use on textiles and garments. Plaintiff's Statement of Undisputed Facts ("SUF") SUF 1.

Unicolors' designer, Hannah Lim, claims that she created a design titled EH101, that is the subject of this suit. SUF 9, 14. Unicolors obtained a copyright for this design. SUF 8. Unicolors had fabric made that contained the EH101 design. SUF 10.

Unicolors sent an electronic copy of EH101 to a supplier, located in China so that it could produce production yardage. SGDMF 51. Specifically, Unicolors ordered 25,650 yards of EH101 fabric from its trusted vendor in Shanghai, China. SGDMF 52. The fabric was shipped directly from the manufacturer in Shanghai, by boat, to Unicolors in Los Angeles. SGDMF 53. There is no evidence that any of this fabric was distributed in China, or not otherwise shipped directly to Unicolors as ordered. SGDMF 54. Plaintiff has not presented evidence of any other orders that it placed for EH101 fabric.

Thereafter through February 2012, Unicolors re-sold this EH101 yardage, which totals approximately 47,000 yards to its customers, all of which were located in Los Angeles. SGDMF 55. All shipments were made to addresses in Los Angeles. SGDMF 56. Approximately 80% of these sales (or about 38,500 yards) were to a single company, located in Los Angeles. *Id.*

In 2013, Unicolors sold 136 yards of EH101 to a company in Mexico, this yardage was either picked up in Los Angeles, or shipped to Mexico. SGDMF 57. Unicolors CEO and designated 30(b)(6) witness testified that this was closeout yardage, meaning Unicolors was getting rid of fabric that it couldn't otherwise timely sell and it sold it for deeply discounted prices. *Id.* In 2014, Unicolors made a single sale of 495 yards to a company in Dallas, Texas. SGDMF 58. Unicolors CEO and designated 30(b)(6) witness was not aware of any other sales of EH101 fabric. SGDMF 59.

### **C. H&M's Garments Bear a Design that was Independently Created**

In or around 2015, H&M sold an Oliver Jacquard wrap jacket and a W Rio skirt ("Accused Garments") made from fabric designed by Shaoxing DOMO Apparel Co, Ltd. ("DOMO"). SGDMF 37. The jacket and skirt are the subjects of this lawsuit.

DOMO has a copyright registration covering the design (“Xue Xu”) found on the jacket and skirt. SGDMF 38. The copyright was issued by the Copyright Bureau of Zhejiang Province on or about September 22, 2015. *Id.* China is a signatory to the Berne Convention. See *Lilith Games (Shanghai) Co. v. uCool, Inc.*, 2015 WL 4149066, at \*1 (N.D. Cal. July 9, 2015).

Xue Xu was independently created by Chinese designer, Xiaomin Qian, and is an original work of authorship. SGDMF 39. Ms. Qian confirmed that she created the design. SGDMF 40. Ms. Qian identified her source inspiration, including images from a public domain pattern idea book, which she adapted in creating the design. *Id.* Ms. Qian further confirmed that she did not see EH101 and, of course, did not copy EH101 or otherwise use EH101 to create Xue Xu. SGDMF 41.

#### **D. H&M Did Not Design or Manufacture the Accused Garments**

The jacket and skirt were designed in Sweden, and manufactured by two companies in China, Real Hope International Limited and Hempel China Limited. SGDMF 42. The manufacturers then shipped the Accused Garments for sale at H&M. SGDMF 44. The manufacturers also shipped finished garments to other companies, in other countries, for sale in strictly foreign stores. SGDMF 76-77.

At no time did H&M, DOMO, or the designers in Sweden have direct access to EH101. SGDMF 46-49. Nor is there any indirect evidence that demonstrates that H&M, DOMO, or the designers had access to EH101. SGDMF 50.

#### **E. H&M Lost Money on Sales of the Accused Garments**

H&M lost approximately \$183,239 on sales of the jacket and skirt. SGDMF 78. Alternatively, if allocated store expenses are not deducted, H&M realized profits of approximately \$33,750 from its use of the fabric design. *Id.*

### **III. STANDARD FOR MOTION FOR SUMMARY JUDGMENT**

The rule on summary judgment is well-understood and non-controversial: Summary judgment is proper where “there is no genuine issue as to any material fact and ... the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P.

1 (“Rule”) 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). The Court  
 2 may also enter judgment in favor of the nonmovant if there is no genuine dispute as to  
 3 any material fact, and the non-moving party is entitled to judgment as a matter of law.  
 4 See Rule 56(f); *Norse v. City of Santa Cruz*, 629 F.3d 966, 971, n.2 (9th Cir. 2010).  
 5 Here, the parties have agreed that Unicolors would be the moving party and, as  
 6 recommended by the Court’s standing rule, H&M would present its request for  
 7 summary judgment in its response. As shown below, there are no disputes of material  
 8 fact and H&M is entitled to judgment, as a matter of law, on all claims.

9 **IV. THE FABRIC DESIGN WAS INDEPENDENTLY CREATED AND IS**  
 10 **COVERED BY A VALID COPYRIGHT REGISTRATION**

11 Independent creation is an absolute defense to an allegation of copyright  
 12 infringement. Here, the evidence of independent creation is overwhelming, and  
 13 undisputed, and entitles H&M to judgment as a matter of law.

14 **A. Xue Xu was Independently Created and Protected by Copyright**

15 Xiaomin Qian independently created Xue Xu (falling snow), which is protected  
 16 by a copyright registration issued by the Zhejiang Provincial Government on or about  
 17 September 22, 2015. SGDMF 38-39. DOMO is the registered owner of the copyright  
 18 for Xue Xu. SGDMF 38. DOMO has provided H&M with a copy of its copyright  
 19 registration. Additionally, for purposes of this case, the copyright registration was  
 20 certified by the US Embassy in Shanghai as an official government document, making  
 21 it admissible as such. Rule 902; Riordan Decl., Ex. 42-43.

22 A copyright registration certificate constitutes prima facie evidence in favor of  
 23 the holder that the design has the following: “(1) originality in the author; (2)  
 24 copyrightability of the subject matter; (3) a national point of attachment of the work,  
 25 such as to permit a claim of copyright; [and] (4) compliance with applicable statutory  
 26 formalities.” 4-13 M. Nimmer & D. Nimmer, *Nimmer on Copyright* (“Nimmer”) §  
 27 13.01 (2015); Dkt. No. 21, at 5. Because the copyright registrations were filed within  
 28 5 years of creation, the registrations have a presumption of validity, meaning that the

1 fabric used in the H&M garments is presumed to be a work of original authorship and  
2 there was no copying.

3 A defendant's valid copyright registration is prima facie evidence that the  
4 protected design was independently created. *Roth Greeting Cards v. United Card*  
5 *Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970) ("originality necessary to support a  
6 copyright merely calls for *independent creation*"); *Lamps Plus, Inc. v. Seattle Lighting*  
7 *Fixture Co.*, 345 F.3d 1140, 1144 (9th Cir. 2003) (copyright certificate constitutes  
8 valid evidence of the originality and ownership of the design it protects).

9 This is equally true for copyrights issued by the Chinese government, which are  
10 protected and enforceable in the United States pursuant to the Berne Convention.  
11 *Lilith Games*, 2015 WL 4149066, at \*1 (Chinese copyright holder brought  
12 "infringement claim under the Berne Convention, an international agreement  
13 governing copyright, to which both the United States and China are signatories");  
14 *Creative Tech., Ltd. v. Aztech Sys. Pte., Ltd.*, 61 F.3d 696, 700 (9th Cir. 1995) (Berne  
15 Convention mandates "a policy of national treatment in which copyright holders are  
16 afforded the same protection in foreign nations that those nations provide their own  
17 authors.")

18 Unicolors has presented no evidence, nor could they, to rebut the presumption  
19 of validity of DOMO's copyright.<sup>1</sup> *Lamps Plus*, 345 F.3d at 1144 (opposing party  
20 must offer some evidence or proof to rebut presumption of validity); *Hamil America,*  
21 *Inc. v. GFI*, 193 F.3d 92, 98 (2d Cir. 1999) (same).

## 22 **B. The Accused Garments Contain the Design Xue Xu**

23 DOMO used Xue Xu to design and manufacture the fabric that was used to  
24 make the Accused Garments. SGDMF 37-38. This fabric was then used by Real

25 <sup>1</sup> Unicolors' argument that Xue Xu is a derivative of EH101 is puzzling. DOMO has  
26 a copyright registration for Xue Xu, the designer attested that she created it and,  
27 unlike Unicolors, provided her source inspiration. SGDMF 38-41. Further, Xue Xu's  
28 designer denied seeing EH101, copying it, or otherwise using it to help create Xue Xu.  
*Id.* This evidence, and the presumption of validity, is buttressed by expert testimony  
into the origins of Xue Xu. Report of Expert Robin Lake ("Lake Report"), ¶¶ 8-19.



1 Hope and Hempel to manufacturer the Accessed Garments. SGDMF 42.

2 Accordingly, summary judgment must be entered in H&M's favor because  
3 there is undisputed evidence of independent creation. *Walker v. Viacom Int'l, Inc.*,  
4 2008 WL 2050964, at \*9 (N.D. Cal. May 13, 2008) (summary judgment appropriate  
5 where defendant shows independent creation), *aff'd*, 362 F. App'x 858 (9th Cir. 2010).

6 **V. H&M IS NOT LIABLE FOR COPYRIGHT INFRINGEMENT**<sup>2</sup>

7 Assuming, *arguendo*, that the Accused Garments are not made from fabric  
8 containing DOMO's copyrighted design, which they are, Unicolors' claims still fail  
9 because there is no evidence of access or substantial similarity. Accordingly, H&M is  
10 independently entitled to summary judgment on this ground as well.

11 **VI. UNICOLORS CANNOT PROVE THAT H&M ACCESSED EH101**

12 To succeed on its copyright infringement claim, Unicolors must prove that  
13 H&M accessed EH101. *Bernal v. Paradigm Talent & Literary Agency*, 788 F. Supp.  
14 2d 1043, 1052 (C.D. Cal. 2010); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481  
15 (9th Cir. 2000). Here, there is no evidence of "access" and Unicolors' infringement

16 <sup>2</sup> Unicolors has submitted a copyright registration that purports to include EH101,  
17 among other designs. As discussed herein, H&M submits that the evidence is  
18 sufficient for judgment to be entered in H&M's favor or, at the least, for summary  
19 judgment to be denied as to both parties. For purposes of this opposition and motion  
20 only, H&M will not dispute that EH101 is protected by copyright VA 1-770-400. If  
21 the Court is inclined to grant summary judgment for Plaintiff, H&M respectfully  
22 moves, pursuant to Rule 56(d) for additional time to conduct discovery into source  
23 material and computer files that relate to the alleged creation of EH101 and other  
24 designs covered by this registration, as it appears Unicolors has withheld key evidence  
25 on these very points.

26 To wit, after Unicolors' 30(b)(6) deposition, counsel for Unicolors said it could  
27 not produce files discussed by the deponent showing *inter alia*, source material for  
28 EH101, and records relating to the other designs covered by Registration VA 1-770-  
400 and its communications with the suppliers who produced the initial yardage of  
EH101 (which invoices are also curiously missing) due to a computer virus.  
Declaration of Staci Riordan ("Riordan Decl."), ¶ 14. These records likely show (or  
disprove) whether all designs covered by VA 1-770-400 were created by the same  
author and all were first published at the same time. 37 C.F.R. § 202.3(b)(4)(i)(B).  
Contrary to counsel's statement, the designer of EH101 claimed that the files were on  
her desktop when she left the company, after the computer virus occurred, and she  
believed that they had been recovered. SGDMF 80. Those files are responsive to  
numerous discovery requests, bear upon the validity of Copyright VA 1-770-400, and  
should have been produced. Riordan Decl., ¶ 14. H&M requests that the files be  
produced and submitted to the Court, prior to any ruling in favor of Unicolors.

1 claim therefore fails as a matter of law.<sup>3</sup> *Three Boys*, 212 F.3d at 481.

2 Access may be shown by proving the defendant had an “opportunity to view or  
3 copy” the design. *Kamar International v. Russ Berrie & Co.*, 657 F.2d 1059, 1062  
4 (9th Cir. 1981). To satisfy this standard, a plaintiff must show more than that the  
5 defendant had a “bare possibility” of access; rather, the plaintiff must show that the  
6 defendant had a “reasonable possibility” to view the plaintiff’s work. *Meta-Film*  
7 *Assoc. v. MCA, Inc.*, 586 F. Supp. 1346, 1355 (C.D. Cal. 1984). Plaintiff has  
8 presented no evidence of direct access, and must therefore rely on circumstantial  
9 evidence to show access. SGDMF 45-47. The circumstantial evidence, either via a  
10 chain of events or widespread dissemination, does not show that H&M (or even  
11 DOMO, or the Garment Designers), accessed EH101. *Three Boys*, 212 F.3d at 482.

12 **A. Plaintiff Has Not Established Facts Demonstrating Direct Access**

13 Plaintiff has produced no evidence that H&M had direct access to EH101.  
14 Plaintiff cannot establish such direct access, and does not appear to claim otherwise.  
15 Mtn at 13.

16 **B. Plaintiff Has Not Established Access By A “Chain of Events”**

17 It is also undisputed that H&M did not access EH101 via chain of events. Mtn  
18 *passim*; SGDMF 50. Plaintiff has presented no facts, as there are none, that there is a  
19 “chain of events that link the plaintiff’s work and the defendant’s access.” *Art Attacks*  
20 *Ink, LLC v. MGA Entertainment Inc.* (“*Art Attacks*”), 581 F.3d 1138, 1143 (9th Cir.  
21 2009). Plaintiff cannot establish access via chain of events.

22 **C. Plaintiff Has Not Shown Access By Widespread Dissemination**

23 To prove access by widespread dissemination, Unicolors must prove that  
24 EH101 was so widely sold that H&M must have seen it. In order to do so, Unicolors  
25 must present undisputed evidence that provides context **and** quantification of the  
26

27 <sup>3</sup> Plaintiff might also establish infringement by showing EH101 and Xue Xu are  
28 “strikingly similar.” As discussed below in Section IV.D, Unicolors cannot meet that  
heightened burden on the evidence here.



1 Plaintiff's alleged sales and sampling (i.e., dissemination) so that it is probable that  
 2 the defendant copied it in creating its design. *L.A. Printex Indust. Inc. v. Aeropostale,*  
 3 *Inc.*, 676 F.3d 841, 847-48 (9th Cir. 2012).

4 For example, in *Art Attacks*, the plaintiff contended that there was widespread  
 5 dissemination of the work at issue because: (1) the work was displayed in retail stores  
 6 and at Plaintiff's booth at a county fair where millions attended; (2) the work was  
 7 printed on T-shirts, "which serve as 'walking billboards,'" of which 2,000 units were  
 8 sold per year; and (3) the work was available to view and purchase on the Internet.  
 9 581 F.3d at 1144-1145. The court disagreed, found the above described dissemination  
 10 was not widespread, held that plaintiff failed to show "more than a 'bare possibility'"  
 11 of access and granted summary judgment in favor of the defendant. *Id.* at 1145.

12 Similarly, in *Rice v. Fox Broadcasting Co.*, the court held that 17,000 videos  
 13 sold over a 13-year period "cannot be considered widely disseminated," even though  
 14 the plaintiff showed that there was a great deal of publicity surrounding the release of  
 15 the video, various niche publications ran stories about the video, and the video was  
 16 featured on *Entertainment Tonight*. *Rice*, 330 F.3d 1170, 1178 (9th Cir. 2003).

17 Additionally, in *Jason v. Fonda*, the plaintiff alleged that she sold 2,000 copies  
 18 of her book nationwide, with somewhere between 200-700 of those units sold in  
 19 Southern California, where the defendants were located. 526 F. Supp. 774 (C.D. Cal.  
 20 1981) *aff'd*, 698 F.2d 966 (9th Cir. 1982). The court held that extent of distribution  
 21 "creates no more than a 'bare possibility' that defendants may have had access to  
 22 plaintiff's book", and that such bare possibility was insufficient to create a genuine  
 23 issue of fact. *Fonda*, 526 F. Supp. at 776-77. Without evidence of access, summary  
 24 judgment was entered in favor of defendants, and affirmed on appeal. *Id.*

#### 25 **1. No Facts Showing Widespread or Relevant Dissemination**

26 To show access by widespread dissemination, the Motion alleges that:  
 27  
 28

- 1 • Unicolors sold over 85,000 yards of fabric between February 2011 and
- 2 2015<sup>4</sup>
- 3 • DOMO is located approximately 100 miles from a company that
- 4 manufactured EH101 fabric for Unicolors; and
- 5 • It is common for US companies to send fabric to China to be converted into
- 6 finished garments.

7 Even if the evidence supported these contentions, which it does not, they are not  
 8 sufficient to show anything more than a “bare possibility” that H&M (or DOMO, or  
 9 the Garment Designers) viewed EH101, which is insufficient to show access. *Art*  
 10 *Attacks*, 581 F.3d at 1143 (bare possibility legally insufficient to establish access via  
 11 wide spread dissemination).

## 12 2. H&M Did Not Access EH101 via Widespread Dissemination

13 It is undisputed that H&M did not design or manufacture the Accused  
 14 Garments. SGDMF 42. H&M had no role in selecting the fabric design to be used in  
 15 the Accused Garments. SGDMF 43. Unicolor’s bare allegation that because H&M  
 16 has retail stores in Los Angeles, where Unicolors is located, H&M could have seen  
 17 EH101 fabric is conclusory and irrelevant, not to mention false. *Rice*, 330 F.3d at,  
 18 1178; *Fonda*, 526 F. Supp. at 776–77. Thus, Unicolors’ claim that H&M accessed  
 19 EH101 via wide spread dissemination fails.

## 20 3. DOMO Did Not Access EH101 via Widespread Dissemination

21 Even if Unicolors’ three allegations of wide spread dissemination were true,  
 22 which they are not, they do not show a reasonable possibility that DOMO viewed  
 23 EH101.<sup>5</sup> There is no evidence that Unicolors’ fabric supplier distributed any EH101

24 <sup>4</sup> The facts are contrary, approximately 48,000 yards were sold, almost all to Los  
 25 Angeles based customers, and almost all between March 2011 and February 2012.  
 26 SGDMF 55-58.

27 <sup>5</sup> DOMO is not a party to this action, nor could it be. *Daimler AG v. Bauman*, 134 S.  
 28 Ct. 746, 751, (2014) (discussing requirements for personal jurisdiction over foreign  
 entity); see also *Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*, 24 F.3d 1088, 1093  
 (9th Cir. 1994) (“undisputed axiom that United States copyright law has no  
 extraterritorial application”). Whether DOMO accessed EH101 is irrelevant to

1 fabric inside China. The only evidence is that Unicolors ordered 25,000 yards of  
 2 EH101 from a single company, that was shipped, by boat, from Shanghai to Los  
 3 Angeles. SGDMF 52. Nor is there any evidence how much, if any, EH101 fabric was  
 4 disseminated in China. See, e.g., *LA Printex*, 676 F.3d at 852. The fact that two  
 5 companies are 100 miles apart, or even closer, is irrelevant to show access without  
 6 evidence as to the volume of product that was disseminated (here, there is no evidence  
 7 any volume of product disseminated in China). *Rice*, 330 F.3d at 1178; *Fonda*, 526 F.  
 8 Supp. at 776–77.

9 Finally, it is rank speculation that a US based company purchased EH101 from  
 10 Unicolors, sent that fabric to China, and DOMO somehow viewed it. Plaintiff has not  
 11 produced any evidence to support such speculation. In fact, certain of Unicolors’  
 12 customers confirmed they did not send EH101 to China, or to H&M. SGDMF 81.

13 The evidence does not support a “reasonable possibility” that DOMO viewed  
 14 EH101. Even if it was theoretically “possible” that it occurred, such bare possibility is  
 15 legally insignificant. *Art Attacks*, 581 F.3d at 1143; *LA Printex*, 676 F.3d at 852.  
 16 Moreover, any such “possibility” is directly refuted by the actual evidence, which is  
 17 that DOMO’s designer, Ms. Qian, did not see EH101, before creating Xue Xu. Any  
 18 contention that DOMO had access to EH101 fails, as matter of law and fact.

#### 19 **4. The European Garment Designers Did Not Access EH101 via** 20 **Widespread Dissemination**

21 Lastly, the Motion may be construed to claim that the designers of the accused  
 22 jacket and accused skirt somehow saw EH101.<sup>6</sup> Mtn at 14. That claim likewise fails

23 copyright infringement allegations against H&M. Nonetheless, because Unicolors  
 24 seems to be alleging that DOMO saw EH101 in creating Xue Xu, H&M addresses  
 25 those allegations here.

26 <sup>6</sup> Like DOMO, the designer of the Accused Garments is a foreign entity, and is not a  
 27 party to this action, nor could it be. See cases cited in n.6, *supra*. Therefore whether  
 28 they accessed EH101 is irrelevant to Unicolors copyright infringement allegations  
 against H&M. Nonetheless, since Unicolors seems to be alleging that they could have  
 seen EH101 because EH101 was allegedly widespread, H&M addresses those  
 allegations here.

1 as there is no evidence that EH101 was distributed in Europe, specifically Sweden,  
2 where those designers are located. SGDMF 65.

3 Unicolors has not produced any evidence showing it was reasonably possible  
4 that H&M, or even DOMO or the European designers of the Accused Garments had  
5 access or otherwise viewed EH101. Accordingly, Unicolors' claim of access via  
6 widespread dissemination fails.

7 **D. Unicolors Cannot Meet Its Access Burden via Striking Similarity**

8 In rare occasions, courts allow a plaintiff to avoid proving access based on the  
9 striking similarity doctrine. This is not such a case.

10 The rule of *striking similarity* applies only when, "as a matter of logic, the only  
11 explanation [for the similarities] between the works must be 'copying rather than  
12 coincidence, independent creation, or prior common source.'" *Bernal*, 788 F. Supp.  
13 2d at 1052 (*quoting* Nimmer § 13.02[B]). Here, there is undisputed evidence of  
14 independent creation of Xue Xu - the copyright and Ms. Qian's sworn testimony -  
15 and, thus, copying is not and cannot be the only explanation.<sup>7</sup>

16 Where, like here, a defendant has a copyright registration, which is *prima facie*  
17 evidence its work was independently created and original, the plaintiff is precluded  
18 from relying on the doctrine of striking similarity as an alternative to pleading access.  
19 *Testa v. Janssen*, 492 F. Supp. 198, 203 (W.D. Pa. 1980) (works properly not found  
20 strikingly similar when perceived similarities explained by independent creation);  
21 *Stratchborneo v. Arc Music Corp.* 357 F. Supp. 1393, 1403 (S.D.N.Y 1973) (striking  
22 similarity only demonstrable when defendant's work not a result of independent  
23 creation).

24  
25 <sup>7</sup> H&M could not find any cases where a court found there was striking similarity  
26 when the accused infringing item was protected by a copyright registration. *See, e.g.,*  
27 *Unicolors, Inc. v. Urban Outfitters, Inc.*, 2017 WL 1208459, at \*5 (9th Cir. Apr. 3,  
28 2017); *Lambert*, at \*5 (C.D Cal. June 16, 2014); *Three Boys*, 212 F. 3d at 485; *Baxter*  
*v. MCA*, 812 F.2d 421,423-24 (9th Cir. 1987). This makes sense as the presence of a  
copyright for the accused work is *prima facie* evidence of independent creation, which  
undercuts the assumption on which the rule of striking similarity is built.

Even if a defendant cannot present a copyright registration – which is not the case here – a court may still conclude that the defendant’s design was independently created and thus require the plaintiff to prove access. *Bethea v. Burnett*, 2005 WL 1720631, at \*15 (C.D. Cal. June 28, 2005). In the Ninth Circuit, to determine whether it is likely that the defendant’s design was independently created, courts examine whether: (i) a prevalence of patterns containing similar subject matter exist in the public domain; (ii) the works contain stock elements; and (iii) where the works contain distinct differences. *Lambert Corp. v LBJC Inc.*, 2014 WL 2737913, at \*5 (C.D. Cal. June 16, 2014); also *Star Fabrics, Inc. v. The Wet Seal, Inc., et. al.*, Dkt. No. 23, p. 3 (C.D. Cal. Mar. 27, 2015) (distinct differences in the works increase likelihood of independent creation). As discussed in more detail below in Section VII, all of the *Lambert* factors weigh in favor of finding that the Supplier independently created Xue Xu.<sup>8</sup>

Accordingly, since striking similarity is precluded, Unicolors must instead prove copying via direct or indirect access. As stated above, Unicolors has no evidence to show access. Thus, the Court must enter summary judgment in H&M’s favor.

## **VII. EH101 AND XUE XU ARE NOT SUBSTANTIALLY SIMILAR**

Even if the Court disregards the valid copyright registration and Plaintiff could show access, or the Court found that was a question for the jury, summary judgment for H&M would still be appropriate because the works are not substantially similar. And, if the Court is not inclined to grant summary judgment for H&M, given the wealth of evidence there is no substantial similarity, the most the Court should find is

<sup>8</sup> Unicolors is aware that DOMO has a copyright registration for Xue Xu. Unicolors has not rebutted the presumption of its validity. Still, the Motion ignores the registration and speciously urges the Court to apply the factors utilized by the Seventh Circuit in *Selle v. Gibb*. 741 F.2d 896, 903-904 (7th Cir. 1984). Even if that case was binding on this Court, which it is not, and even if it applied when there is a valid copyright registration as is the case here, which it does not, the *Selle v. Gibbs* does not dictate a finding of striking similarity here. *Id.* at 905 (striking similarity only appropriate if defendant had no explanation of coincidence, independent creation or common source).

1 that there is question of fact for the jury. *Twentieth Century-Fox Film Corp. v. MCA,*  
 2 *Inc.*, 715 F.2d 1327, 1329-30 (9th Cir. 1986); *Ent'mt Research Grp. V. Genesis*  
 3 *Creative Grp.*, 122 F.3d 1211, 1217 (9th Cir. 1997) (“[A]n infringement defendant  
 4 must simply offer some evidence or proof to dispute or deny the plaintiff’s prima facie  
 5 case of infringement”).

6 The burden of proving both substantial and striking similarity is the sole  
 7 responsibility of the Plaintiff, who must demonstrate such similarity of *protectable*  
 8 elements from EH101. *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir. 2002).  
 9 To determine whether two works are substantially similar, the Court must engage in  
 10 an “extrinsic test,” including “an objective comparison of specific expressive  
 11 elements” found within the works. *Cavalier*, 297 F.3d at 822.<sup>9</sup>

12 Here, despite over a year of litigation, Plaintiff has failed to identify any  
 13 evidence of protectable similarities between the parties’ works. Plaintiff has not done  
 14 this because, as discussed in H&M’s prior motion to dismiss (Dkt. No. 10), and as  
 15 reinforced below, EH101 consists only of public domain shapes and icons over which  
 16 Plaintiff cannot assert copyright protection. Furthermore, even if EH101 is not held to  
 17 be entirely unprotectable, EH101 and Xue Xu have multiple, material, and evident  
 18 differences between them. Plaintiff also cannot successfully assert a thin copyright  
 19 over its work. Plaintiff’s allegations are not supported by the evidence in this case,  
 20 and its Motion must be denied.

21 **A. The Unprotected Elements Of The Shape Pattern Must Be Filtered**  
 22 **Out Before It Is Compared With The Garments**

23 The Ninth Circuit has repeatedly held that only protected expression may be  
 24 considered in evaluating substantial similarity. Public domain, generic, and *scènes à*  
 25

26 <sup>9</sup> While Plaintiff must also satisfy an intrinsic test – measuring whether a reasonable  
 27 observer would conclude that the works are substantially similar – a “plaintiff who  
 28 cannot satisfy the extrinsic test necessarily loses on summary judgment, because a  
 jury may not find substantial similarity without evidence on both . . . tests.” *Kouf*, 16  
 F.3d at 1045; *Smith*, 84 F.3d at 1218.



1 *faire* elements “are not protectable” under copyright law; the court must “filter out and  
2 disregard the non-protectable elements in making its substantial similarity  
3 determination.” *Funky Films*, 462 F.3d at 1077 (citation omitted).

4 As part of the filtering process, a court’s comparison of copyrighted works to  
5 allegedly infringing designs must include “analytic dissection”: an objective  
6 comparison of each *isolated* element of each work to the exclusion of the works’ other  
7 elements, combinations of elements, and expressions therein. *Apple Computer Inc. v.*  
8 *Microsoft Corp.*, 35 F.3d 1435, 1442-43, 1446 (9th Cir. 1994) (court must eliminate  
9 uncopyrightable elements via “analytic dissection,” a “successive filtering method”);  
10 *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1474-75 (9th Cir. 1992); *Dr.*  
11 *Seuss Enterprises, L.P. v. Penguin Books, USA, Inc.*, 109 F.3d 1394, 1398 n.3 (9th  
12 Cir. 1997).

13 Analytic dissection is used explicitly for the purpose of determining “whether  
14 similarities [between the works] result from unprotectable [or unprotected]  
15 expression.” *Data Eas USA v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988). Thus,  
16 analytic dissection is used not to compare similarities and identify infringement, but to  
17 define and carefully delimit the scope of plaintiff’s copyright.<sup>10</sup>

18 Unprotectable elements of a work include: (1) ideas, as opposed to expression;  
19 (2) expressions that are indistinguishable from underlying ideas; (3) standard or stock  
20 elements (*scènes à faire*); (4) facts; and (5) public domain images and information.  
21 *Erickson v. Blake*, 839 F. Supp. 2d 1132, 1136 (D. Or. 2012); *Satava v. Lowry*, 323 F.  
22 3d 805, 810 (9th Cir. 2003) (“Expressions that are standard or stock, or common to a  
23 particular subject matter or medium are not protectable . . .”).

24 A comparison of protectable elements – as opposed to the entirety of EH101 –  
25 ensures that unprotectable expression does not form the basis for a determination of  
26

27 <sup>10</sup> Despite this requirement, as discussed below, Plaintiff has attempted to conduct the  
28 extrinsic test based on EH101 in its entirety. This is entirely inappropriate.

1 substantial similarity, thereby “confer[ring] a monopoly of [an] idea upon the  
2 copyright owner.” *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987).

3 **B. EH101’s Standard And Stock Elements Are Not Protectable**

4 The Code of Federal Regulations explicitly bars “familiar symbols or designs”  
5 from copyright protection. 37 C.F.R. § 202.1. Federal courts across the United States  
6 have thus held that images comprised of publicly available icons, pre-existing works,  
7 and basic or obvious shapes and forms – including “variations” on those basic shapes  
8 and forms – cannot provide a basis for a copyright infringement action. *See, e.g.*  
9 *Tompkins*, 1983 WL 398, at \*2 (holding that “[v]ariations of squares, rectangles,  
10 circles and ellipses” have long been in the public domain and cannot be the basis of a  
11 copyright); *Todd*, 379 F. Supp. 2d at 1114 (copyright protection for barbed wire  
12 jewelry denied as design and shape of barbed wire “has been in the public domain for  
13 years”); also *Stern*, 99 F. App’x at 778; *Ellison*, 903 F. Supp. at 1360; *Domingo*, 2000  
14 WL 262597 at \*1-3; and Mary Campbell Wojcik, *The Antithesis of Originality:*  
15 *Bridgeman, Image Licensors, and the Public Domain*, 30 Hastings Comm. & Ent. L.J.  
16 257, 267 (2008).

17 **C. Unicolors Relied Upon And Borrowed From Ancient And Public**  
18 **Domain Patterns In Creating The Shape Pattern**

19 Artwork and fabric patterns substantially similar to EH101 have been in  
20 common use for over a millennium. For example, EH101 is virtually identical to  
21 publicly available icons, designs, and shapes – including fabric patterns – from Maya,  
22 Inca, Aztec, and other civilizations of Central and South America, and from  
23 publications of modern patterns based on those designs which are readily available to  
24 clothing designers (collectively, the “Shape Collections”). Lake Report, ¶¶ 22-30.  
25 Indeed, Plaintiff’s designer **admits** that EH101’s elements were directly inspired by  
26 “an Aztec art style I had become familiar with by visiting the Natural History  
27 Museum.” Dkt. No. 64-3, p. 3.  
28



1 The elements constituting EH101 were not merely inspired by these styles – in  
2 some instances they are identical to images that appear in public domain works. This  
3 can be confirmed through analytic dissection of each repeated element in EH101.

4 In the Motion, as well as the declaration of its alleged designer,<sup>11</sup> Unicolors  
5 claims that EH101 consists of six pattern elements depicting: (1) a man standing next  
6 to a tiki house; (2) waves; (3) pebbles; (4) a fish; (5) a “simple geometric design” in  
7 the shape of a diamond; and (6) an unnamed “geometric design” with an angled,  
8 banked shape.<sup>12</sup> Mtn at 8-11; Dkt. No. 64-3, ¶ 4-9. As established by H&M’s expert,  
9 Robin Lake, public domain art virtually identical to each and every one of these  
10 elements can be found in pattern “idea” books utilized by textile designers across the  
11 world, as well as in natural history museum collections. Lake Report, ¶¶ 22-28.  
12 Furthermore, public domain art exists also exists for the elements of EH101 that  
13 Unicolors did not discuss in the Motion. *Id.* ¶ 29, Ex. O.

14 **Public Domain Art**

15 **EH101**



24 <sup>11</sup> Unicolors’ CEO testified that EH101 was “inspired by artwork purchased from a  
25 design studio, Milkprint, LLC.” Dkt. No. 64-4, p. 5. Remarkably, only days after  
26 Unicolors alleged designer was deposed, and gave contrary testimony, Unicolors’  
27 CEO declared that he “had a misunderstanding about the inspiration.” *Id.*, p. 5

28 <sup>12</sup> Only four elements of the EH101 are actually claimed by Unicolors. When asked  
about the different bands in EH101 during her deposition, Ms. Lim only identified  
four key elements; teepee house and person, fish, waves, and pebbles. Only now, in  
connection with the Motion, are the other two bands discussed. SGDMF 72.



This side-by-side comparison illustrates the common qualities of the elements that make up EH101, and their undeniable presence in the public domain. More examples of comparable imagery in the public domain is provided with the expert report of Robin Lake.<sup>13</sup>

**D. The Use Of Triangles, Diamonds, “X” Symbols, Pyramids, and Circles Are Scènes à Faire and Unprotectable In Fabric Patterns**

Under the doctrine of *scenes a faire*, “courts will not protect a copyrighted work from infringement if the expression embodied in the work necessarily flows from a commonplace idea . . . the rationale is that no one party should have a monopoly on the underlying unprotectable idea.” *Skyy*, 225 F.3d at 1082; *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489 (9th Cir. 1984); *Durang*, 711 F.2d at 143. As explained by the court in *Frybarger v. International Business Machines Corp.*, “when similar features in [works] are . . . at least standard in the treatment of a given [idea], they are treated like ideas and are therefore not protected by copyright.” 812 F.2d 525 (9th Cir. 1987); *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 382, 392-93 (S.D.N.Y. 2005) (elements of a photograph image showing a woman’s feet, shoes and handbag do not enjoy copyright protection due to *scenes a faire*).

<sup>13</sup> Although copyright protection may exist for combination of un-original elements, such protection is not warranted in this case, as discussed in Section VIII below.

Here, as shown above, and within the Lake Report, EH101 contains many “stock” icon, design, and shape elements, including: (1) the use of triangles and diamonds in a “hashing” or conjoined pattern; (2) the use of “x” shapes in “negative space” to create a geometric pattern; (3) the use of rough-hewn pyramid shapes to create additional “negative space” and to provide the illusion of balance between elements; and (4) the use of concentric circles, one of the most obvious of all fabric pattern elements. Lake Report., ¶¶ 22-30.

These generic icons, designs, and shapes, their variations and the layouts and/or arrangement, are, and have been throughout history, common design elements in fabric and other artwork patterns.<sup>14</sup> *Id.* EH101 is comprised largely of images identical, or very nearly identical, to images found in numerous public domain sources. Without sufficient protectable elements, EH101 is not an original expression that warrants copyright protection.<sup>15</sup> Accordingly, Plaintiff’s Motion must be denied.

#### **VIII. EH101 IS NOT PROTECTABLE AS A COMBINATION OF OTHERWISE UNPROTECTABLE ELEMENTS**

Otherwise unprotectable elements, if numerous enough and the arrangement original enough, may be eligible for copyright protection over their arrangement. *Satava*, 323 F. 3d at 811 (“it is not true that any combination of unprotectable elements automatically qualifies for copyright protection”) (*emphasis original*). If protection is provided due to a combination of otherwise unprotectable elements, however, the underlying elements are not protected, but merely how those elements are positioned vis-à-vis each other. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

<sup>14</sup> As shown by the vast universe of public domain patterns similar to EH101, there is no originality in the concept of interlacing contrasting patterns in lines across a fabric pattern. Lake Report, ¶¶ 22-30.

<sup>15</sup> Unicors’ failure to present an original arrangement of its unprotectable elements also bars Unicors from claiming even a “thin” copyright over its work. *Lucky Break Wishbone Corp. v. Sears Roebuck and Co.*, 528 F. Supp. 2d 1106, 1123-1124 (W.D. Wash. 2007) (quoting *Satava*, 323 F.3d at 812) (“[A] thin copyright ‘compris[es] no more than [the artist’s] original contribution to ideas already in the public domain’”).

As discussed above (see n.12), Unicolors now claims that EH101 consists of six pattern elements. Mtn at 8-11; Dkt. No. 64-3, ¶ 4-9. A pattern consisting of six unprotectable elements is not sufficiently numerous enough to warrant protection. *Satava*, 323 F.3d at 811-12 (six otherwise unprotectable elements were not found numerous enough to warrant protection); *Lamps Plus*, 345 F.3d at 1146-47 (four elements not found numerous enough to warrant protection).

Unicolors' arrangement of its unprotectable elements is not sufficiently original. Unicolors' elements are arranged and formatted into stacked rows of multi-lined repeats, a format required by Unicolors' chosen medium and manufacturing requirements. Unicolors' choice to arrange its unprotectable elements in stacked rows is an unremarkable and common practice in the medium of fabric, as confirmed by public domain and commercially available prints which predate Unicolors' alleged creation. Lake Report ¶¶ 22-30. Indeed, it is required by the fabric medium; if Unicolors did not do this, its textile could not be made into consistently patterned clothing by manufacturers.

Assuming, *arguendo*, that the Court deems the arrangement protectable, that protection only extends to the spacing and placement of the elements, not to the underlying elements themselves.<sup>16</sup> *L.A. Printex*, 676 F.3d at 850. When two works are derived from public domain sources, and utilize similar unprotectable motifs, the arrangement and choices of the designers needs to be examined closely to determine whether the works are similar. Lake Report ¶¶ 31-38. Here, when so analyzed the works have numerous differences such that a finding of infringement is precluded. *Id.*

## **IX. MANUFACTURING HAS NO BEARING ON THE SUBSTANTIAL SIMILARITY ANALYSIS**

In an attempt to influence the Court's comparison of the Works, Unicolors' designer claims that the differences between EH101 and the Accused Products can be

<sup>16</sup> And such arrangement should only be given "thin" protection in this case, given the public domain sources and common arrangement. *Lucky Break*, 528 F. Supp. 2d at 1123-24.

1 attributed to the medium and method used to create them: “The technique of using the  
 2 knit of a knit fabric to create a pattern cannot achieve the same level of detail that  
 3 printing on a fabric can . . . resulting in sections of the [Accused Products] which  
 4 appear to be blank space or random patterns of dots.” Dkt. No. 64-3, p. 4. Unicolors’  
 5 designer is wrong.

6 Works constructed from yarn and jacquard looms – for example, intricate  
 7 tapestries – are capable of containing exceptional detail. Lake Report ¶¶ 32, 38.  
 8 Neither the use of yarn nor a jacquard loom explains the significant and evident design  
 9 differences between the works. Rather than supporting similarity, as Unicolors  
 10 contends, the absence of similar details between EH101 and Xue Xu is a product of  
 11 their respective designs.

12 **X. COMPARISON REVEALS EH101 AND XUE XU ARE NOT**  
 13 **SUBSTANTIALLY SIMILAR**

14 Even if we assume, *arguendo*, that EH101’s elements are protectable, which  
 15 they are not, or the combination of the elements have protection, which H&M disputes  
 16 in light of the public domain materials showing similar arrangements, the substantial  
 17 and material differences between EH101 and the Accused Products make plain that  
 18 they are far from substantially similar, must less virtually identical, or even strikingly  
 19 similar as Plaintiff claims. Lake Report ¶¶ 31-38.

20 First, EH101’s diamond pattern has a vertical, hand-drawn presentation,  
 21 complete with four distinct layers. *Id.* In contrast, the Accused Products have a far  
 22 more simple, horizontal diamond with only two layers, as well as equally proportional  
 23 triangle shapes above and below it:



24  
 25  
 26  
 27  
 28 *Id.*



1 The second line of EH101 contains an intricate, multi-lined “cross-hatched”  
 2 ribbon element, which stands in strong contrast to the Accused Products’ randomized,  
 3 speckled band. *Id.* ¶ 32. Plaintiff argues that the Accused Products’ band is a mere  
 4 “misprint” or bowdlerization of EH101, created by the use of yarn and a jacquard  
 5 loom to create the Accused Products. *Id.* As discussed in Section IX above, however,  
 6 this manufacturing format actually supports independent creation, rather than copying:



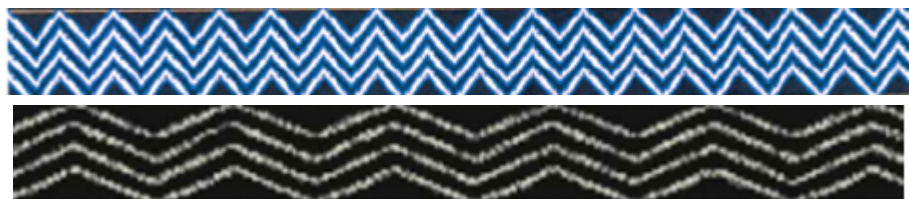
11 *Id.*

12 Next, EH101 presents a “man standing next to tiki house.” *Id.* ¶ 33. Much like  
 13 the Works’ dissimilar diamonds, both EH101 and the Accused Products contain  
 14 triangle shapes in their main elements, but the triangle shapes are entirely distinct and  
 15 unrelated. *Id.* EH101 has six distinct layers of texture, and a narrow, sharp angle to  
 16 its triangles. *Id.* The Accused Products, on the other hand, contain broad, flowing  
 17 mountain shapes. *Id.* Further differences exist between EH101’s “face” and the  
 18 Accused Products’ sun – EH101’s face element has rigid, squared-off, ear-like edges,  
 19 where the Accused Products portray a consistently striated, sun-like sphere:



23 *Id.*

24 Underneath this central element, EH101 portrays narrow, choppy, and tightly  
 25 packed waves, a stark difference from the Accused Products’ loose, wide, and  
 26 horizontally flowing zig-zags. Again, the differences are evident to the untrained eye:



1 *Id.* ¶ 34.

2 EH101 next contains a band depicting a rounded, octagon-like element, a stark  
3 difference from the Accused Products' wide, sloping hexagon shape. *Id.* ¶ 35. The  
4 details within each band are distinct as well – where EH101 has an open, horizontal  
5 oval at its center, The Accused Products contain a spare, vertical pair of stud-like dots:



7  
8 *Id.*

9 Continuing to move down EH101, the viewer next sees a frenetic band of hand-  
10 drawn, irregular pebbles, which share little similarity to the Accused Products' large,  
11 crisp, uniform diamonds. *Id.* ¶ 36. EH101's unevenly spaced, open-centered  
12 presentation stands in bold contrast to the Accused Products' shared, thin, unadorned  
13 edges and bold, stud-dotted centers:



15  
16  
17 *Id.*

18 Finally, EH101 contains a second prominent element: a fish with thin, mirrored  
19 “arms” curling back into the element's center. *Id.* ¶ 37. The Accused Products, on the  
20 other hand, contain a chunky butterfly form with four arms – each of which terminates  
21 out into different detailed sub-elements. *Id.* The most prominent of these sub-  
22 elements includes a thin, leafy protuberance with three leaves and a perfectly round  
23 ball with a dot in its center, totally unlike anything found in EH101:



25  
26  
27  
28 *Id.* ¶ 37.

Unicolors' substantial similarity arguments fail to bear weight. While both patterns' rely on public domain artwork consisting of basic geometric shapes and common tropes in the field of "ethnic" textile design, their expression of such public domain work is distinct from each other.

Unicolors may argue that the number or arrangement of rows in the two works is similar, and claim that is proof of copying. They would be wrong. Here, the designer of Xue Xu has specifically identified another image, with rows aligned in a similar fashion, as a source and inspiration of Xue Xu. Lake Report, ¶¶ 9-12, Ex. C. There is nothing unique, original, or protectable, about arranging series of images into bands for fabric design. Any similarity to EH101 is coincidence. *Bernal*, 788 F. Supp. 2d at 1052. If Unicolors had produced the source material and creation files for EH101, it may very well contain another image, or more, with similar row alignment. No substantial similarity exists between EH101 and Xue Xu, and Plaintiff's Motion must be denied in full.

#### **XI. THE WORKS ARE NOT VIRTUALLY IDENTICAL**

Even if this Court were to hold that EH101 has a "thin" copyright, which is the most it should have, if it has anything, Unicolors must prove virtual identity to succeed on its claim. *Skyy*, 323 F.3d at 766 (holding that the plaintiff possessed a "'thin' copyright which protects against only virtually identical copying").

Because the two works are not substantially similar, as shown above, they cannot be virtually identical, which is further basis to grant H&M's Motion.

#### **XII. H&M CANNOT BE SECONDARILY LIABLE FOR EXTRATERRITORIAL INFRINGEMENT**

Plaintiff alleges direct infringement against H&M for sales of 10,801 units of Infringing Garments in the U.S. Mtn at 17. Plaintiff further charges H&M with secondary liability for international sales, by other entities<sup>17</sup>, of additional units of

<sup>17</sup> Plaintiff does not identify the direct infringing entities except that they are not domestic and their sales were international. Mtn at 18-21.



1 Infringing Garments. Mtn at 18.

2 As a matter of law, under the Copyright Act and long-standing precedent, H&M  
3 cannot be secondarily liable for infringement that occurs outside the United  
4 States. *Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*, 24 F.3d 1088, 1095–96 (9th  
5 Cir. 1994) (cited therein); *Columbia Pictures Indus., Inc. v. Fung*, 2009 WL  
6 6355911, at \*7 (C.D. Cal. Dec. 21, 2009), *aff'd in part as modified*, 710 F.3d 1020  
7 (9th Cir. 2013); Nimmer § 12.04[A][3][a], at 12–86, (United States' copyright laws  
8 have no application to extraterritorial infringement predates the 1909 Act); *Peter Starr*  
9 *Prod. Co. v. Twin Continental Films, Inc.*, 783 F.2d 1440, 1442 (9th Cir. 1986)  
10 (“infringing actions that take place entirely outside the United States are not  
11 actionable in United States federal courts.”)

12 Secondary liability depends, in the first instance, on actionable infringement. If  
13 the accused sales take place outside the United States, however, those sales do not  
14 violate the Copyright Act, which “has no extraterritorial application. *L.A. News Serv.*  
15 *v. Reuters Television Int'l, Ltd.*, 149 F.3d 987, 990 (9th Cir. 1998). Without a  
16 predicate violation of the Copyright Act, there can be no secondary liability;  
17 contributory or vicarious infringement exists only if the “underlying direct  
18 infringement occurred in the United States.” *Perfect 10, Inc. v. Yandex N.V.*, 2013  
19 WL 4777189, at \*8-9 (N.D. Cal. Sept. 6, 2013).

20 Here, except for sales directly made by H&M (for which it cannot also be  
21 secondarily liable), all other accused sales occurred outside the United States, as  
22 Plaintiff concedes in its papers. Mtn at 18. Thus, and as a matter of black-letter law,  
23 H&M cannot be found liable for contributory or vicarious infringement.

### 24 **XIII. UNICOLORS' ALLEGED DAMAGES**

25 Even if Unicolors could prove infringement, which it cannot, the damage  
26 amounts set forth in the Motion are wholly without support. Without an expert, or  
27 actual evidence, counsel for Unicolors simply multiplied the full retail price by the  
28 number of units sold. There is no evidence that H&M sold the units at full retail

1 price; the only evidence is to the contrary. Declaration of Chelsea Wharton, ¶ 22;  
 2 Riordan Decl., Ex. 41 (Expert Report of Justin Lewis, p. 10). Nor is there any  
 3 evidence on the volume of garments sold by other companies in other countries, or the  
 4 price of those sales (even if those were relevant data points).

5 Counsel's calculations are sheer speculation and insufficient to establish a  
 6 recoverable damages amount. *Polar Bear Prods., Inc. v. Timex Corp.*, 384 F.3d 700,  
 7 711 (9th Cir. 2004) (plaintiff must proffer some evidence that infringement caused the  
 8 targeted revenue). The only reliable figures for Unicolors' alleged damages (i.e.,  
 9 disgorgement) are those contained in H&M's Expert report.

#### 10 **XIV. H&M'S FEES**

11 If the Court grants summary judgment for H&M, H&M is entitled to its  
 12 attorney fees as the prevailing party. 17 U.S.C. § 505.

#### 13 **XV. CONCLUSION**

14 H&M's design was independently created; EH101 and Xue Xu are neither  
 15 strikingly nor substantially similar, and Unicolors cannot provide any evidence of  
 16 access. There is no viable predicate act to support a claim for secondary infringement.  
 17 Because Unicolors cannot establish a triable issue of fact with respect to the foregoing  
 18 issues, H&M is entitled for summary judgment as a matter of law.

19  
 20 Dated: May 1, 2016

NIXON PEABODY LLP

21  
 22 By /s/ Staci Jennifer Riordan

23 Staci Jennifer Riordan

24 Jessica Walker

Attorneys for Defendant

H & M HENNES & MAURITZ LP